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REMARKS/ARGUMENTS

Claims 9-14 are pending in this Application. By this amendment, Applicants cancel claims 15-20.

Since the Examiner has failed to specifically respond to any of Applicants' arguments for patentability, Applicants respectfully request that, in response to the present amendment, the Examiner specifically respond to the arguments for patentability presented below.

Claims 9-11 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by Person et al. (U.S. 5,321,573). Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Person et al. in view of Nagakubo et al. (U.S. 5,966,938). Claims 15-17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Person et al. Claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Person et al. in view of Nagakubo et al. (U.S. 5,966,938). Applicants have canceled claims 15-20. Applicants respectfully traverse the rejections of claims 9-14.

Claim 9 recites:

"A manufacturing method of a chip-type composite electronic component comprising the steps of:

forming an inductor characteristic sheet by laminating a ceramic layer having an internal coil conductor;

forming a thermistor characteristic sheet by laminating a ceramic layer having an internal electrode and having a predetermined resistance-temperature characteristic;

forming a compound multilayer body by adhering the inductor characteristic sheet and the thermistor characteristic sheet by pressure with a diffusion-prevention layer sandwiched therebetween;

baking a compound multilayer body;

forming external electrodes on an end surface of a compound multilayer body in which at least one end part of an internal coil conductor and at least one end part of an internal electrode are exposed." (emphasis added)

Applicants' claim 9 recites the step of "forming a thermistor characteristic sheet."

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With the improved method steps and features of claims 9 and 15, Applicants have been able to provide a method of manufacturing a small-sized chip-type composite electronic component in which the impedance can be changed depending upon the temperature (see, for example, the last full paragraph on page 1 of the Specification).

The Examiner has alleged that reference numbers 24 and 26 and line 28 of column 7 to line 16 of column 8 of Person et al. teaches the step of "forming a thermistor characteristic sheet" recited in Applicants' claims 9 and 15. Applicants respectfully disagree.

The Examiner is respectfully reminded that MPEP § 2121.01 states:

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ". In re Hoeksema, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention.

Applicants respectfully submit that Person et al. is not enabling for the step of "forming a thermistor characteristic sheet" recited in Applicants' claims 9 and 15 because (1) reference numbers 24 and 26 are directed to varistors, **NOT thermistors** as recited in Applicants' claims 9 and 15; (2) the only mention of thermistors in Person et al. is in claims 11 and 12; and (3) Person et al. does not place Applicants' claimed invention in possession of the public because Person et al. only mentions thermistors in the claims and fails to provide any disclosure or teachings regarding thermistors. In fact, the entire specification of Person et al., except for claims 11 and 12, is completely silent regarding any thermistors. Thus, the specification of Person et al. clearly fails to provide any support for the recitation of the "thermistors" in claims 11 and 12. It appears that the recitation of the "thermistors" in claims 11 and 12 of Person et al. is nothing more than a typographical error, and should have been "varistors."

Thus, contrary to the Examiner's allegation, Person et al. fails to teach or suggest the step of "forming a thermistor characteristic sheet" as recited in Applicants' claims 9

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and 15.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 9 under 35 U.S.C. § 102(b) as being anticipated by Person et al. and claim 15 under 35 U.S.C. 103(a) as being unpatentable over Person et al.

The Examiner has relied upon Nagakubo et al. to allegedly cure various deficiencies in Person et al. However, Nagakubo et al. fails to teach or suggest the feature of "forming a thermistor characteristic sheet" in combination with the other method steps and features recited in Applicants' claims 9 and 15.

Accordingly, Applicants respectfully submit that Person et al. and Nagakubo et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in claims 9 and 15 of the present application. Claims 10-14 depend upon claim 9 and are therefore allowable for at least the reasons that claim 9 is allowable. Claims 16-20 depend upon claim 15 and are therefore allowable for at least the reasons that claim 15 is allowable.

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicant petitions the Commissioner for a Two-month extension of time, extending to April 18, 2004, the period for response to the Office Action dated November 18, 2003.

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The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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Attorneys for Applicants

Joseph R. Keating
Registration No. 37,368

Christopher A. Bennett
Registration No. 46,710

KEATING & BENNETT LLP
10400 Eaton Place, Suite 312
Fairfax, VA 22030
Telephone: (703) 385-5200
Facsimile: (703) 385-5080